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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/664,444	09/19/2003	Michael O. Norris	18525-0784	4531
39943	7590	07/01/2005	EXAMINER	
PHILIP G. MEYERS LAW OFFICE 1009 LONG PRAIRIE ROAD, SUITE 300 FLOWER MOUND, TX 75022			TRAN, KHOI H	
			ART UNIT	PAPER NUMBER
			3651	

DATE MAILED: 07/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/664,444

**Applicant(s)**

NORRIS ET AL.

**Examiner**

Khoi H. Tran

**Art Unit**

3651

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 16-20, 22, 23 and 32-36 is/are pending in the application.
- 4a) Of the above claim(s) 23 and 36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 16-20, 22 and 32-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

  
**KHOI H. TRAN**  
**PRIMARY EXAMINER**

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Claim 23 remains withdrawn from further consideration per previous Office Action pursuant to 37 CFR 1.142(b), as being drawn to a nonelected Grouping, there being no allowable generic or linking claim.

### ***Claim Objections***

2. Claims 17 and 36 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

In regards to claim 17, the claimed failed to further limit the scope of the invention. Replacement of step (e) in claim 32 for step (e) in claim 17 does not further limit the scope of the claimed invention.

In regards to claim 36, the claim depends upon a canceled claim 11.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claim 17 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The scope of claim 17 cannot be ascertained. For example, it is not distinct whether steps (f) and (g) would remain within the combination of the claim.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 16-20, 22, and 32-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rosenbaum et al. 5,031,223 in view of IBM reference submitted by the Applicant, or in view of Koenck 6,688,523, or in view of Patel et al. 6,766,955.

Rosenbaum '223 discloses a method of processing mail pieces per claimed invention. The method comprises positioning an OCR scanner above a mail piece to capture the address data within a selected region of said mail piece, correlating, verifying said scanned data against address information held in a database, and printing a unique identification in the form of a barcode onto said mail piece after the OCR scanner scanned said mail piece (Figure 2). The method comprises transmitting a signal including scanned image data to a computer 23 (Figure 2). The method comprises forwarding the mail piece to a destination point that corresponds to the address data. If the scanned is readable by the OCR, the method comprises determining a postal zip code corresponding to the destination address (column 4, paragraph "1.", and Figure 2) and then applying a barcode representing the postal zip code corresponding to the destination address. If the scanned data is not readable or not verifiable, the captured address data and image on the mail piece will be forwarded to a video coding system, at a workstation, so that an operator can manually modify the

address data on a video screen (Figures 8-10). However, Rosenbaum '223 is silent as to the specifics of manually positioning the OCR device to capture the selected region on the mail piece. Nevertheless, it is obvious that the OCR device in Rosenbaum could be manually adjusted, at any scanning instances or at least during the start up of the system, so that correct focusing distance between the camera and the scanned objects can be achieved for proper image capturing.

IBM reference, Koenck '523, and Patel '955 also disclose the commonly well-known portable handheld OCR scanning device for manually identify objects or regions on an object.

It would have been obvious for a person with ordinary skill in the art, at the time the invention was made, to have manually positioned a handheld OCR scanner to Rosenbaum '223 system in order to capture the image on the mail piece. The modification facilitates another commonly well-known means for capturing image via an OCR device.

In regards to claim 22, the limitation of the handheld OCR scanner in the instant claimed invention presents no novel or unexpected result over the OCR scanner used in the reference. Since portable handheld OCR scanners are commonly well known, as demonstrated by IBM, Koenck, and Patel '955, use of such portable OCR scanning means in lieu of the OCR scanner used in Rosenbaum '223 provides no stated problem and would be an obvious matter of design choice within the skill of the art. In re Launder, 42 CCPA 886, 222 F.2d 317, 105 USPQ 446 (1955).

In regards to claim 34, Rosenbaum '223 region of interest is less than the side of the mail piece oriented toward the OCR.

In regards to claim 35, Rosenbaum '223 computer interfaces with a national address database for matching address information from a mail piece with valid destination address.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 32, 16-20, 22, and 33-35 have been considered but are not persuasive.

Applicant argued that Rosenbaum 5,031,223 does not teach applying a postal zip code to the mail piece. This argument is not persuasive. Applicant's attention is directed to column 4, paragraph "1.". From this paragraph, it is clear that the barcode attached to the mail piece reflects the resolves city/state/zip address on the mail piece. Rosenbaum '225 does teach applying a postal zip code to the mail piece.

Applicant argued that Rosenbaum '223 teaches away from the usage of a manual handheld device for scanning the mail piece based on the mentioning of "on-line OCR's" (column 5, lines 36-37). This argument is not persuasive. An "on-line OCR" does not exclude a handheld OCR. As the name indicates, an "on-line OCR" only reflects the possibility of connecting the OCR to an Internet network.

3. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the

references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, at least it is the commonly well-known knowledge of using a handheld OCR scanner for manually scanning objects or regions on an object that provide the motivation to combine the references, as indicated above.

### ***Conclusion***

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

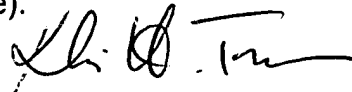
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khoi H. Tran whose telephone number is (571) 272-6919. The examiner can normally be reached on Monday-Thursday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Crawford can be reached on (571) 272-6911. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Khoi H Tran  
Primary Examiner  
Art Unit 3651

KHT  
06/29/2005